

## REMARKS

This communication is in response to the final Office Action issued January 3, 2007. The Examiner rejected claims 1-12 and 14-18 under 35 U.S.C. § 103 in view of varying combinations of U.S. Patent Nos. 5,823,890 to Maruko *et al.* ("Maruko"), 5,783,293 to Lammi ("Lammi"), and 4,998,734 to Meyer ("Meyer").

### Claim Rejections Under 35 U.S.C. § 103

In sections 1-4 of the Office Action, the Examiner rejected claims 1-12 and 14-18 under 35 U.S.C. § 103 in view of varying combinations of Maruko, Lammi, and Meyer. Specifically, the Examiner rejected:

- claims 1-12 and 14-17 in view of Lammi modified by Maruko, and
- claim 18 in view of Lammi modified by Maruko and Meyer.

It is well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, each and every recitation of the claim must be present in the cited reference(s). See, for example, MPEP § 2143.03. It is also well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, there must be some suggestion or motivation to modify a reference or combine reference teachings. See, for example, MPEP § 2143.01. When so modifying a reference, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. See, for example, MPEP § 2143.01. The modification must support a reasonable expectation of success with some degree of predictability. See, for example, MPEP § 2143.02. Finally, the source of the suggestion or motivation to modify a reference cannot be the Applicants' own disclosure. See, for example,

MPEP § 2143. For at least the reasons stated below, the Examiner's rejections of the claims do not satisfy these burdens.

*Claims 1-12 and 14*

The Examiner rejected claims 1-12 and 14 by merely referencing the rejections of the July 7, 2006 non-final Office Action. The Applicants therefore incorporate herein the comments made in the October 10, 2007 Response to Office Action.

Additionally, the Applicants note that the Examiner's rejection states:

Lammi, however, does not teach a multi-color layer; providing a first portion of the material with a first pigment additive; and providing a second portion of the material with a second pigment additive, the second pigment being a different color than the first pigment additive. Maruko et al teaches a golf ball (col 1, lns 38-42); and a multi-color cover layer, wherein the layers have different colors. Maruko et al also inherently teaches that color additives were used. Lammi and Maruko et al are combinable because they are analogous with respect to golf balls. *Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to color the cover layers of Lammi as taught by Maruko et al in order to form a good appearing golf ball.*

July 7, 2006 Office Action at pages 2-3 (emphasis added). The portion of Maruko relied upon by the Examiner states:

The problem becomes serious in the cover of two layer structure consisting of inner and outer layers, particularly when a color difference exists between the inner and outer layers, more particularly when the inner layer has a higher lightness and a darker color than the outer layer. *If such a cover is formed by a heat compression molding method, tracks of seams and streaks formed on the inner layer at the parting line are perceived prominent through the outer layer. Such a poor outer appearance reduces the commodity value of a completed ball.*

Maruko at col. 1, lines 38-47 (emphasis added).

Thus, the Examiner's rationale for modifying the Lammi golf ball is to produce a golf ball having "a poor outer appearance." The Applicants respectfully submit that a skilled artisan would strive to *avoid* creating a golf ball with a "poor appearance" and having a "reduce[d] commodity value" rather than intentionally creating such a golf ball as suggested by the

Examiner. Furthermore, the Examiner's assertion that such an appearance is "good" is unsupported and in direct contrast to the express language of Maruko.

In view of the foregoing, the Examiner's rejections of the claims are believed to be overcome. The Applicants request that the rejections be withdrawn and a Notice of Allowance be issued.

#### *Claims 15-17*

The Examiner's rejection of claims 15-17 appears to be virtually identical to the rejections of claims 1-12 and 14. The Applicants, therefore, incorporate the remarks previously made regarding claims 1-12 and 14.

In view of the foregoing, the Examiner's rejections of the claims are believed to be overcome. The Applicants request that the rejections be withdrawn and a Notice of Allowance be issued.

#### *Claim 18*

The first portion of the Examiner's rejection of claim 18 appears to be virtually identical to the rejections of claims 1-12 and 14. The Applicants, therefore, incorporate the remarks previously made regarding claims 1-12 and 14.

Furthermore, the Applicants note that Claim 18 recites *inter alia*:

- selecting a material;
- providing a first portion of said material with a first pigment additive;
- providing a second portion of said material with a second pigment additive, said second pigment additive being of a different color than said first pigment additive; and
- injecting said first and second materials to form said multi-color layer;

By the Examiner's admission, Maruko does not teach nor suggest forming a single cover layer of multiple colors. *See* the July 7, 2006 Office Action at pages 4-5. Moreover, the entire thrust of Maruko is to avoid visible color differentiation. *See, for example*, Maruko at col. 1, lines 43-48.

Thus, the Examiner has failed to identify each and every recitation of the claims, a requirement for a proper rejection. *See, for example*, MPEP § 2143.03.

Furthermore, regarding the Meyer reference, it is noted that Meyer discloses using a lacquer layer to form the shiny, high-gloss outermost layer. *See* Meyer at col. 2, lines 19-21 and 59-61. There is no disclosure nor suggestion, however, that this lacquer layer is formed via an injection process.

The Applicants have amended claim 18 above to correct a typographical error. Entry of the amendment is respectfully requested.

In view of the foregoing, the Examiner's rejection of the claim is believed to be overcome. The Applicants request that the rejections be withdrawn and a Notice of Allowance be issued.

#### Additional Fees

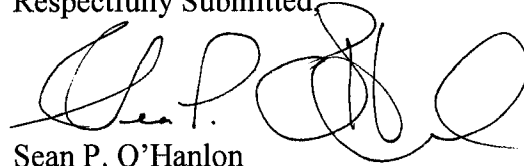
The Commissioner is hereby authorized to charge any insufficiency or credit any overpayment associated with this application to Bingham McCutchen LLP Deposit Account No. 19-5127 (order no. 4200020383).

#### Conclusion

Claim 18 has been amended. Claims 1-18 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicants respectfully request reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel

further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Sean P. O'Hanlon", written in a cursive style.

Sean P. O'Hanlon  
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